

REMARKS

This application has been reviewed in light of the Office Action dated October 5, 2005. The pending Claims are 18-44, with Claims 18, 22 and 27 being in independent form. Claims 27 and 43 have been amended to even further clarify the claimed subject matter. Favorable reconsideration is respectfully requested.

The above claim changes were presented in an Amendment filed in the United States Patent and Trademark Office on September 28, 2005, in reply to the Office Action dated June 28, 2005. That Amendment crossed in the mail with the Office Action dated October 5, 2005, which is understood to have been issued to correct an error appearing in the June 28, 2005 Office Action. In a telephone conversation on November 21, 2005, the Examiner informed the undersigned that the Amendment filed September 28, 2005 has not been entered. Accordingly, the claim changes set forth in that Amendment are presented again herein.

The Office Action at page 7 states that Claims 40-42 are objected to as being dependent from a rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner is sincerely thanked for this indication.

Claims 27 and 43 have been objected to at paragraph 1 of the Office Action for alleged minor informalities, with the Examiner having kindly suggested specific amendments for obviating these objections. Without conceding the propriety of the objection to Claims 27 and 43, and solely to expedite prosecution, Claims 27 and 43 have

been amended herein as suggested by the Examiner. Accordingly, the objections are believed to be overcome.

Claim 43 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness in allegedly repeating at lines 5 and 6 the limitation recited in line 4. To obviate this rejection but without conceding correctness, Applicants have amended Claim 43 as deemed necessary to overcome this rejection. Accordingly, withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Further in the Office Action, Claim 22 was rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to set forth the subject matter regarded as the present invention, and additionally for being allegedly incomplete for omitting essential steps. In particular, the Office Action states that the method of Claim 22 is not what Applicants regard as their invention because the method does not require use of a bezel, and that Claim 22 omits essential steps involving use of the bezel. Reconsideration of these Section 112 rejections is respectfully requested in view of the following comments.

With regard to the Section 112 requirement that a claim set forth subject matter which an applicant regards as the invention, MPEP 2172 states:

A rejection based on the failure to satisfy this requirement is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

....
Evidence that shows that a claim does not correspond in scope with that which applicant regards as applicant's invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant The content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention. As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA

1979), agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.

....
The second paragraph of 35 U.S.C. 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971)
(some citations omitted) (Emphasis in text added).

The Office Action supports the assertion that Claim 22 is not directed to subject matter which Applicants regard as their invention by citing "the specification filed on February 10, 2004". However, as stated in the above-quoted portion of MPEP 2172, the content of the specification is not usable as evidence to support an assertion that the scope of a claim is inconsistent with subject matter which Applicants regard as their invention. Thus, the Office Action's citation of the specification is believed to be improper evidence supporting the applicable Section 112 rejection. Moreover, nothing in the record offers any other evidence to support the assertion that Claim 22 fails to correspond in scope to what Applicants regard as their invention. In the absence of such evidence, the invention set forth in Claim 22 must be presumed to correspond with what Applicants regard as their invention, according to MPEP 2172. Moreover, as stated in MPEP 2172, the second paragraph of Section 112 is irrelevant to a determination of whether there is commensurate agreement between the specification and claims.

With regard to the allegation that Claim 22 omits essential features, MPEP 2172.01 is authoritative, and states that "essential matter . . . include[s] missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention." It is respectfully submitted that

nothing in the record, including the present application, supports a conclusion that a bezel is essential to performing a method of optically coupling as set forth in Claim 22. To the contrary, use of a bezel is not a necessary feature of such an inventive method, nor is it described as being necessary in the specification.

Indeed, one skilled in the art clearly would appreciate in view of the specification and drawings that use of the bezel is preferred, rather than necessary or essential to the method of optically coupling of the invention, and that the coupler can be coupled to the module and the attenuator, whether or not a bezel is employed. Such a skilled artisan also would recognize that there is no reason why a bezel would be “essential” or necessary to accomplish such coupling, and that it is within the scope of the invention (and Claim 22) to optically couple an optical attenuator to a communication module, whether or not a bezel is employed.

Furthermore, it is significant to note that the Patent and Trademark Office has issued parent U.S. Patent No. 6,695,485 B1 that includes claims (e.g., Claims 35-52) directed to a method for optically coupling an optical attenuator to a communication module, but which do not recite or necessarily require use of a bezel. It would be inconsistent, therefore, at the very least, for the Patent and Trademark Office to now reject claims in the present application under Section 112, because they do not necessarily require a bezel.

For all of the foregoing reasons, it is believed that both of the Section 112, second paragraph, rejections have been obviated, and thus their withdrawal is respectfully requested.

Claims 22-27, 31-38, 43 and 44 were rejected in the Office Action under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,188,827 (Stephenson) (hereinafter "Stephenson '827").

The rejection of independent Claim 22 over Stephenson '827 will first be addressed. Independent Claim 22 recites:

22. A method for optically coupling an optical attenuator to a communication module disposed on an internal side of a panel, comprising the steps of:
 optically coupling an optical coupler to the communication module through an opening in the panel that provides access from an external side of the panel to the communication module; and
 optically connecting an end of the optical attenuator to the optical coupler, to thereby optically couple the optical attenuator to the communication module through the optical coupler.

The Office Action states at page 4 that "the examiner is broadly interpreting the ferrule sleeve 18 as the optical coupler because the optical couple of the instant invention is simply an element optically coupling two optical elements." However, it is respectfully submitted that the ferrule sleeve 18 is not seen to be an optical coupler such as that recited in method Claim 22 because sleeve 18 does not conduct optical energy. For example, Column 7, lines 8-17, of Stephenson '827 describes the ferrule sleeve 18 as follows:

As shown in Fig. 14, the ferrule sleeve 18 is a substantially cylindrical tube having a substantially cylindrical passage 173 formed therein. A continuous longitudinal slot 174 extends from a first end 175 to a second end 177 of the sleeve. In that the ferrule sleeve must flex slightly during installation, it is normally constructed of a flexible but durable material. Presently preferred for this material is metal such as phosphor-bronze, although it will be

appreciated that polymeric or ceramic materials could alternatively be used.

Nowhere is Stephenson '827 seen to teach or suggest that the ferrule sleeve 18 is capable of performing optical coupling to conduct optical energy.¹ Indeed, the accepted known meaning of "ferrule" is simply that of a ring or sleeve, usually metal, for joining one part to another (*See* excerpt from Merriam-Webster Online Dictionary (enclosed)). The ferrule sleeve of Stephenson '827, therefore, is understood to be merely a mechanical device that mechanically (not optically) joins components together, -- not an optical coupler that couples any optical energy in Stephenson '827.

Claim 22, on the other hand, specifically recites an optical coupler. As can be appreciated in view of at least page 2, lines 1-14 and page 4, lines 9-18 of the specification, and as is well known in the art, optical couplers provide an *optical* coupling or connection in that they have the capability to conduct optical energy between coupled elements.² Therefore, it is within the scope of the "optical coupler" recited in Claim 22 to be a coupler that conducts optical energy or signals. Nothing has been found, or pointed out, in Stephenson '827 that would teach or suggest optically coupling an optical coupler to a communication module through an opening in a panel that provides access from an external side of the panel to the communication module, and optically connecting an optical

^{1/} The ferrule sleeve materials referred to in the above quotation are not understood to have a capability of coupling optical energy.

^{2/} For example, the attached excerpt from the Photonics Dictionary defines a coupler as a "[d]evice for distributing optical power among two or more ports". *See* excerpt, The Photonics Dictionary (attached). Also, in one non-limiting embodiment of the invention, the optical coupler used in the invention can be a SC optical coupler. SC couplers are well known in the art as being devices that conduct optical signals.

attenuator to the optical coupler to thereby *optically couple* the optical attenuator to the communication module through the optical coupler, as recited in Claim 22. Accordingly, Claim 22 is believed to be clearly patentable over Stephenson '827.

The rejection of independent Claim 27 over Stephenson '827 will now be addressed.

Claim 27, as amended, recites:

“27. A mechanical bezel, comprising:
a first, housing portion having an inner channel extending in a direction of a line connecting first and second open ends of the first, housing portion; and
a second portion extending from the first open end of the first, housing portion, and being adapted to couple the mechanical bezel to a communication module disposed on an internal side of a panel, without fixedly securing to the panel itself, so that the first open end is closer to the communication module than the second open end when at least a portion of the mechanical bezel is inserted at least partially through an opening of the panel.”

The Office Action appears to equate the base 12 shown in Fig. 18 of Stephenson '827 with the second portion of the bezel recited in Claim 27. However, in Stephenson '827 the base 12 secures *to the panel* through the upper and lower panel flanges 54 and 56 and the latch tabs 58 of the base 12. Nothing has been found, or pointed out, in Stephenson '827 that would teach or suggest a bezel having a second portion extending from a first open end of a first, housing portion, and being adapted to couple the bezel to a communication module disposed on an internal side of a panel, without fixedly securing to the panel itself, as set forth in Claim 27. Thus, Claim 27 is believed patentable over that cited reference.

Claims 27-32, 34, 35 and 37 were rejected under § 102(e) as allegedly being anticipated by U.S. Patent No. 6,186,670 (Austin et al.).

The recitations of Claim 27 were set forth above. For example, the claim recites a mechanical bezel comprising, in part, a second portion extending from a first open end of a first, housing portion, and being adapted to couple the mechanical bezel to a communication module disposed on an internal side of a panel, without fixedly securing to the panel itself. (Emphasis added)

In Austin et al., on the other hand, the module 10 *does* fixedly secure to the panel 66 through the latch 60 and pinching surfaces 81 and 86 of the module 10. Nothing has been found, or pointed out, in Austin et al., that would teach or suggest the above-emphasized features of Claim 27. Also, the Office Action's identification of the SC connector 100 of Austin et al. as corresponding to the communication module of Claim 27 is respectfully disagreed with. Rather, it appears that the SC connector 100 corresponds to an optical coupler which is not an element of Claim 27.

For all of these reasons, Claim 27 is believed to be clearly patentable over Austin et al.

Claims 18-21 and 39 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Austin et al.

Claim 18 recites:

18. A bezel for facilitating connection between an external device positioned on one side of a communication panel and a module located on an opposite side of the communication panel, the communication panel having an opening for receiving the bezel, the bezel comprising:

- a housing, the housing defining an interior portion;
- a first open end insertable into the module through the opening, wherein the first open end is positioned and configured to receive a first communication connection of the module for connection with the external device; and
- a second open end having an openable cover,
wherein the second open end is configured to receive at least a second communication connection of the external device for connection with the first

communication connection when the openable cover is open, without substantially disrupting operation of the module, and

wherein the interior portion is configured to house an optical coupler for connecting the first communication connection of the module to the second communication connection of the external device.

The Office Action concedes that “the first open end 25 of Austin is not inserted into the module. Instead, the module is inserted into the first open end.”

Nonetheless, the Office Action contends that “[i]t would have been obvious . . . to a person having ordinary skill in the art to modify the bezel taught by Austin such that the first open end is inserted into the module as taught by the instant invention because it only deals with reversal of parts....” This assertion is respectfully disagreed with for the following reasons.

According to MPEP § 2142, various criteria must be met to establish a *prima facie* case of obviousness against a claimed invention:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . Finally, the prior art reference . . . must teach or suggest all the claim limitations. (MPEP 2142, May 2004 Revision, page 2100-128).

The present Office Action provides no reason whatsoever why one skilled in the art would have been motivated to modify the Austin et al. device in the manner postulated in the Office Action, and instead merely states that the proposed modification “only deals with reversal of parts”. However, without any evidence of a motivation for making such a modification, the Office Action’s argument becomes this: if parts are

reversible³, then the reversal of such parts is obvious. But, such reasoning is prohibited under MPEP §2143.01, which states that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination”. (emphasis in the original) (MPEP 2143.01, May 2004 Revision, page 2100-131).

Moreover, although the Office Action contemplates modifying Austin et al. “such that the first open end is inserted into the module”, it is not clear precisely how the end 25 of Austin et al. would need to be modified in order to be capable of being “inserted into the module [i.e., connector 100]” of Austin et al., let alone how the “module” would need to be modified to permit such insertion. Neither is it clear how such a modification could be made without leaving the end face of fiber 102 of the Austin et al. connector 100 exposed to particles, dust, or debris, and while enabling the connector 100 and module 10 to be adapted for being selectively de-coupled from each other. Because Austin et al. seeks to protect the end face of fiber 102 of connector 100 from exposure to particles, dust, or debris, any modification along the lines proposed in the Office Action likely would render the overall Austin et al. device unsuitable for its intended purpose of protecting against such exposure. Thus, for this reason, it is believed that there is no motivation to make the modification of Austin et al. proposed in the Office Action. MPEP 2143.01, May 2004 Revision, page 2100-131 (“If the proposed modification would render the prior art

^{3/} Incidentally, Applicants do not concede that the applicable “parts” of Austin et al. can be reversed successfully or function successfully in reverse.

invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”) (citation omitted).

For these reasons alone, the Office Action has failed to set forth a *prima facie* case of obviousness against Claim 18.

Furthermore, Austin et al. simply does not teach or suggest a bezel in which a first open end is insertable into a module located on an opposite side of a communication panel, as recited in Claim 18. Because it is well established that in order to provide a *prima facie* case of obviousness “all the claim limitations must be taught or suggested by the prior art” (MPEP 2143.03), and Austin et al. does not teach or suggest the foregoing features of Claim 18, it is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness against Claim 18 for this reason as well.

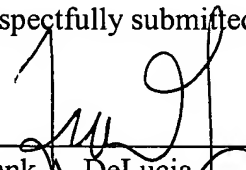
For all of the foregoing reasons, it is respectfully submitted that Claim 18 is clearly patentable over Austin et al.

The other rejected claims in this application depend from one or another of the independent Claims 18, 22, and 27 discussed above, and, therefore, are submitted to be patentable over the art relied on in the Office Action for the same reasons as are those corresponding independent claims. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and the allowance of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



Frank A. DeLucia
Attorney for Applicants
Registration No. 42,476

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 538015v1